

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Art Unit: 1654

TROUP, John P. et al.

Examiner: HA, Julie

Application No. 10/662,678

Confirmation No. 1877

Filed: September 15, 2003

For: NUTRITIONAL COMPOSITIONS

MAIL STOP AMENDMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Dear Examiner Ha:

In response to the Office Action mailed on September 5, 2007, Applicant responds through his attorney as follows:

Restriction was required to one of the following groups under 35 U.S.C. §121:

Group	Claims	Description
I	1-17	Composition comprising amino acids in free form and/or salt form
II	18-20 and 22	Method of ameliorating a condition associated with cachexia and/or anorexia and a method of reducing malnutrition
III	21	Method of stimulating muscle protein synthesis

Applicant provisionally elects Group I, claims 1-17, composition comprising amino acids in free form and/or salt form, with traverse, subject to the Rejoinder provisions of MPEP 821.04.

MPEP 803 states that “[i]f the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions. For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. Further, MPEP 803 provides in the guidelines that “Examiners must provide reasons and/or examples to support conclusions.” In the present application, Applicant respectfully submits that the composition and its limited uses would not create a serious burden on the Examiner. The Applicant believes that the Examiner’s search could be made of both the composition as claimed in claims 1-17 and the use thereof, as claimed in claims 18-22, without undue burden for the Examiner. The composition and its use is intimately related and that a search of references for the elements of claims 1-17 could include a simultaneous search of the references concerning the intended use of the composition of claims 18-22 to ameliorating a condition associated with cachexia and/or anorexia and a method of reducing malnutrition (claims 18-20 and 22) and of stimulating muscle protein synthesis(claim 21). Applicant respectfully requests that the Examiner enter the traversal of the Restriction Requirement.

For the reasons stated above, Applicant respectfully requests that the Restriction Requirement be withdrawn.

§ 1.141 (a) provides “more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claims.” (Claims 1, 2, 8, 11 are found to be generic by the Examiner).

Although not specifically cited by the Examiner, Applicant would like to also note § 1.146 Election of species which provides for the examiner may require the Applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable. However, if

such application contains claims directed to more than a reasonable number of species, the examiner may require restriction of the claims to not more than a reasonable number of species before taking further action in the application. Applicant does not believe that the number of amino acids, intact proteins, n-3 polyunsaturated fatty acids, and vitamin E is more than a reasonable number of species.

Applicant provisionally elects: Amino acid: Methionine; n-3 polyunsaturated fatty acids: EPA (Eicosapentanoic Acid); and Vitamin E component: Tocopherol
Claims 1-11, and 13-17 encompass all of the elected species.

IN THE CLAIMS


Accordingly, claims 18-22 are provisionally withdrawn from consideration as being directed to a non-elected invention, pending review of the traverse above.

For the reasons stated above, Applicant believes that the claims of the present invention exhibit unity of invention, and respectfully request that the finding of lack of unity be withdrawn.

The Commissioner is hereby authorized to charge any additional fees under 37 CFR §1.17 which may be required, or credit any overpayment, to Deposit Account No. 19-0134 in the name of Novartis.

If a telephone interview would be of assistance in advancing the prosecution of the application, Applicant's undersigned attorney invites the Examiner to telephone him at the number provided below.

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Date: October 4, 2007